

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed July 1, 2004. At the time of the Office Action, Claims 36-46 were pending in the Application. Applicant amends Claim 36 and 40. The amendments to the claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 112 Rejections

The Examiner rejects Claim 40 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement in that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant has made an amendment to Claim 40 in order to address the Examiner's concern. Accordingly, this rejection is now moot.

Specification

The Examiner asserts that an entire section describing "Node D" on pg. 46 is missing in the clean version of the patent application. This is not true. Applicant has elected not to describe "Node D" in more specific detail, but this does not result in any inherent deficiency in the Specification. All of the proffered claims are fully supported by the accompanying specification. The functions and operations of "Node D" are provided throughout the specification in sufficient detail and Applicant is not under any obligation to offer more disclosure relating to "Node D."

Section 102 and 103 Rejections

The Examiner rejects Claims 36-44 and 46 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,647,035 issued to Cadeddu et al. (hereinafter "Cadeddu"). The Examiner rejects Claim 45 under 35 U.S.C. §103(a) as being unpatentable over *Cadeddu* in view of Ramaswami et al. (i.e. an article entitled "Optical Networks: A Practical Perspective," hereinafter "Ramaswami"). These rejections are respectfully traversed for the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (See M.P.E.P. §2131.) Additionally, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. (See M.P.E.P. § 2142-43.)

Cadeddu cannot properly support a §102 rejection because it fails to teach, suggest, or disclose each and every limitation of Independent Claim 36. In a similar fashion in addressing the §103 rejection, it is respectfully submitted that the pending claims are patentable over the art of record based on, at least, the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

For example, as amended, Independent Claim 36 generally recites a response to a failure condition that is executed on a channel level and an optical ring that includes an optical switch unit that includes a number of switching blocks that is twice a number of protected channels. First, neither *Cadeddu* nor *Shiragaki* perform such channel level operations. Second, the structure of *Cadeddu* and *Shiragaki* are not capable of maintaining a relationship between the number of switching blocks and the number of protected channels, as identified by Independent Claim 36. Such operations and capabilities are significant. When the failure control is performed at the channel level, instead of the multiplex level, a number of drawbacks are avoided. For example, by operating protection at the channel level, it is possible to provide optical protection to a selected subset of optical channels. In addition, because the reconfiguration takes places at the channel level, each node does not have to be provided with switching equipment to perform protection on all the network channels. (See Original Specification for support: pages 5-6.) Note also that because the number of switching blocks is two times the number of protected channels, greater flexibility is provided. For example, the present invention may accommodate any number of switching blocks (e.g. 64-256) in contrast to other systems. (See Original Specification for support: page 6.)

Applicant further notes that any combination of *Shiragaki* and *Cadeddu* and some other reference that may disclose a channel level operation would be inappropriate in the context of a future potential §103 rejection. This is because there is no evidence to suggest that *Shiragaki*

and *Cadeddu* would be capable of successfully operating in such a fashion. In addition, there is no evidence to support that either of these references could maintain the relationship between the switching blocks and the protected channels. Moreover, there is no teaching, disclosure, or suggestion to make any such combinations. These essential facts would vitiate the other prongs obviousness and, therefore, render the pending claims allowable.

Thus, Independent Claim 36 is allowable over *Cadeddu* and *Shiragaki*. In addition, the dependent claims associated with Independent 36 Claim are also allowable for analogous reasons.

Double Patenting and Provisional Rejections

The Examiner provisionally previously rejected Claims 36-39, 41-44, and 46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 09/608,657 in view of *Cadeddu*. The Examiner also provisionally previously rejected Claim 45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 2 of copending Application No. 09/608,657 in view of *Cadeddu* as applied to Claim 36, and further in view of *Ramaswami*. Because of the amendments to the pending claims, this rejection is now moot.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fees are due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicants invite the Examiner to contact its attorney at the number provided below.

Respectfully submitted,

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